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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

Q137-US2

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10/666,861Filed
September 17, 2003First Named Inventor
Hisashi Tsukamoto et al.Art Unit
1745Examiner
Dah Wei D. Yuan

Applicant requests review of the final rejection in the above-identified patent application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.
Registration number 42,491☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34. _____

Signature

Travis Dodd
Typed or printed name818-833-2003
Telephone number06/14/2007
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below*.

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PATENT
Docket No. Q137-US2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Hisashi Tsukamoto et al.

Serial No: 10/666,861

Filed: September 17, 2003

For: ELECTRIC STORAGE BATTERY
CONSTRUCTION AND METHOD OF
MANUFACTURE

Art Unit: 1745

Examiner: YUAN, Dah Wei D.

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Pre-Appeal Brief Request for Review

This communication is in response to the Office Action mailed on November 13, 2006 (the Office Action). Pending claims 1-9 and 66-71 are rejected for statutory double patenting. The Applicant submits that a clear legal error has been committed in rejecting claims 1-9 and 66-71 for statutory double patenting.

REMARKS

A. The Pending Claims

Claims 1-9 and 66-71 are pending. Claim 1 is the only independent claim pending in the current application. Claim 1 specifies an electric storage battery. The battery includes an electrode assembly in the interior volume of a case. In addition to other limitations, the electrode assembly includes an elongate pin and an elongate mandrel fitted around the pin.

Claim 67 is also at issue in the current application. Claim 67 specifies that "the mandrel includes a tube." Since claim 67 depends from claim 1, claim 67 specifies that "the mandrel includes a tube" and is "fitted around the pin."

Claim 68 is also at issue in the current application. Claim 68 depends from claim 67 which specifies that "the mandrel includes a tube." Claim 68 then specifies that "the pin is positioned in an interior of the tube." Since claim 68 indirectly depends from claim 1, claim

68 specifies that the mandrel “includes a tube” and is “fitted around the pin” with “the pin positioned in (the) interior of the tube”.

Rejection of Claims Under 35 USC §101

Claims 1-9 and 66-71 stand rejected under 35 USC §101 for double patenting in view of U.S. Patent No. 6,670,071 B2 (Skinlo). This rejection is for statutory double patenting as opposed to nonstatutory double patenting. Accordingly, this rejection requires that the claims are to the same invention.

CLAIMS 1-9 AND 69-71

Skinlo has only one Independent Claim which specifies a “mandrel closely fitted around said pin **for mechanically reinforcing said pin**” (emphasis added). In contrast, Claims 1-9 and 69-71 of this application requires a mandrel “fitted around the pin” but do not specify that the mandrel is for mechanically reinforcing the pin. Since the statutory double patenting rejection requires that the conflicting claims are for the same invention, the Office Action argument that claims 1-9 and 69-71 of the current application claims the same invention of Skinlo is a statement that any mandrel “fitted around a pin” is necessarily “for mechanically reinforcing said pin” as required by claim 1 of Skinlo. As a result, the Office Action is asserting that any possible mandrel “fitted around a pin” falls within the scope of the Skinlo claim language of a “mandrel closely fitted around said pin for mechanically reinforcing said pin.”

Since Skinlo includes limitations that are not present in the claims of the current Application, claims 1-9 and 69-71 of the current application each have a different scope than each of the claims in Skinlo and the rejection of claims 1-9 and 69-71 for statutory double-patenting should be withdrawn.

CLAIM 66

Claim 66 of the current application specifies that a crimp connects the mandrel to the pin. None of the Skinlo claims includes this limitation. However, claim 8 of Skinlo does specify that “said mandrel is welded to said pin.” In order to retain the double patenting

rejection of claim 66, the Office Action states “the weld that connects the mandrel to the pin is considered as a crimp that connects the mandrel to the pin.”

As set forth in MPEP 2111, claim terms cannot be given an interpretation that is inconsistent with the specification. Interpreting a weld to be the same as a crimp contradicts the current specification. Note that the first 3 lines on page 3 of the current application include the following language:

The mandrel 48, pin 12, and substrate 32 are then preferably welded together, such as by resistance spot welding or by ultrasonic welding.

Alternatively, the mandrel 48 may be crimped onto the pin 12....

The specification’s use of the term “alternatively” teaches that crimping is an alternative to welding. Hence, the specification teaches that a weld and a crimp are not the same but are alternatives. Since the specification teaches that a crimp is different from a weld, the interpretation relied upon in support of this rejection contradicts the specification and is not proper.

Since claim 66 includes limitations that are not present in the claims of the Skinlo Application, claim 66 of the current application has a different scope than each of the claims in Skinlo and the rejection of claim 66 for statutory double-patenting should be withdrawn.

CLAIM 67

The Office Action also cites claim 67 in responding to Applicant’s arguments. As a result, the Office Action appears to indicate that claim 67 conflicts with the claims of Skinlo. As noted above, Claim 67 specifies that “the mandrel includes a tube” and is “fitted around the pin.” However, claim 67 does not specify that the mandrel is for mechanically reinforcing the pin as required by claim 1 of Skinlo. Since a statutory double patenting rejection requires that the conflicting claims are for the same invention, the Office Action argument that claim 67 of the current application claims the same invention as Skinlo is a statement that any mandrel that “includes a tube” and is “fitted around a pin” is necessarily “for mechanically reinforcing said pin” as required by claim 1 of Skinlo. As a result, the Office Action is asserting that any possible mandrel that “includes a tube” and is “fitted around a pin” falls within the scope of the Skinlo claim language of a “mandrel closely fitted around said pin for mechanically reinforcing said pin.”

Since Skinlo includes limitations that are not present in the claim 67 of the current application, claim 67 of the current application has a different scope than each of the claims in Skinlo and the rejection of claim 67 for statutory double-patenting should be withdrawn.

CLAIM 68

The Office Action also cites claim 68 in responding to Applicant's arguments. As a result, the Office Action appears to indicate that claim 68 conflicts with the claims of Skinlo. As noted above, Claim 68 specifies that the mandrel "includes a tube" and is "fitted around the pin" with "the pin positioned in (the) interior of the tube." However, claim 68 does not specify that the mandrel is for mechanically reinforcing the pin as required by claim 1 of Skinlo. Since a statutory double patenting rejection requires that the conflicting claims are for the same invention, the Office Action argument that claim 68 of the current application claims the same invention as Skinlo is a statement that any mandrel that "includes a tube" and is "fitted around a pin" with "the pin positioned in (the) interior of the tube" is necessarily a mandrel "for mechanically reinforcing said pin" as required by claim 1 of Skinlo. As a result, the Office Action is asserting that that any possible mandrel that "includes a tube" and is "fitted around a pin" with "the pin positioned in (the) interior of the tube" falls within the scope of the Skinlo claim language of a "mandrel closely fitted around said pin for mechanically reinforcing said pin."

Since Skinlo includes limitations that are not present in the claim 68 of the current application, claim 68 of the current application has a different scope than each of the claims in Skinlo and the rejection of claim 68 for statutory double-patenting should be withdrawn.

Conclusion

The Applicant respectfully submits that legal error has been made by rejecting the pending claims for statutory double-patenting. For these reasons, allowance of claims 1-9, 66-71 is respectfully requested.

Respectfully submitted



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